

REMARKS

The Office Action of September 18, 2006, has been considered by the Applicants. No claims have been amended. Claims 1-3, 6-18, 20-27, 30, and 31 remain pending. Reconsideration of the Application is requested.

Claims 1, 3, 14-18, 20, 27, and 31 were rejected under 35 U.S.C. 102(b) as anticipated by Kawamura (2002/0025483). Applicants traverse the rejection.

The Examiner stated that the exemplification of the imaging member in Example 5 having the two charge transport layers with a binder resin and a charge transport material combined with the disclosure of antioxidants and the specific disclosure of one antioxidant provided sufficient disclosure that the artisan would immediately envisage placing stearyl-p-(3,5-di-t-butyl-4-hydroxyphenyl)propionate in the second charge transport layer with the other components as recited.

To anticipate, the reference must teach every element of the claims. Applicants submit that the disclosure would not lead the artisan to immediately envisage the imaging member of the instant claims. In claim 1, the first charge transport layer (CTL) consists of a charge transport compound and a polymer; the second charge transport layer consists of a charge transport compound, a polymer, and one of two specific hindered phenols. In Kawamura's Example 5 (shown on page 25), both charge transport layers consist of a charge transport compound and a polymer.

Kawamura does not teach putting only a hindered phenol in the second charge transport layer. Applicants acknowledge that Kawamura names the Irganox 565 antioxidant of claim 1 in a list of 32 particular antioxidants in paragraph [0294]. However, Kawamura also teaches using a filler (paragraph [0213]), a plasticizer (paragraph [0249]), a leveling agent (paragraph [0249]), a hindered phenol to improve charging (paragraph [0293]), and/or an antioxidant (paragraph [0294]) in the charge transport layer. The Examiner has not shown where Kawamura teaches using only a hindered phenol and excluding the other components. The Examiner has not shown where Kawamura teaches putting these components in only the second layer and not

the first layer. Applicants submit that the Examiner's reasoning in this 102(b) rejection is analogous to improper hindsight reasoning under 103(a).

Because Kawamura does not teach these elements of the claims, he cannot anticipate the instant claims. Therefore, Applicants request withdrawal of the 103(a) rejections.

Claims 1, 3, 6-9, 14-18, 20, 24, 25, 27, 30, and 31 were rejected under 35 U.S.C. 103(a) as obvious over Kawamura. Applicants traverse the rejection.

The Examiner reasoned that it would be obvious to place the antioxidant in the second charge transport layer because the reference specifically teaches that antioxidants are useful in a charge transport layer and with two CTLs, there are only three options when deciding where to put the antioxidant - in the first layer, in the second layer, or in both layers.

Applicants submit that there is no motivation to modify the reference in the stated manner. Again, the composition of both charge transport layers is limited by the transitional phrase "consisting of". Kawamura, however, teaches the possible addition of filler, plasticizer, leveling agent, hindered phenol to improve charging properties, and antioxidant. The Examiner's reasoning as to adding hindered phenol applies to every permutation and combination of these additives taught by Kawamura, and the Examiner has not shown where Kawamura teaches adding only the hindered phenol. In this regard, Applicants submit that the Examiner is choosing an imaging member where only the hindered phenol is added based on improper hindsight reasoning. There is no teaching or discussion that would limit or point the artisan to the claimed imaging member besides the Applicants' disclosure.

For this reason, Applicants request withdrawal of the 103(a) rejection based on Kawamura.

Claims 10-13, 21-23, and 26 were rejected under 35 U.S.C. 103(a) as obvious over Kawamura in view of Yuh (6,261,729). Applicants traverse the rejection.

These claims are dependent on claim 1. If claim 1 is non-obvious, then so are its dependent claims; MPEP § 2143.03, *In re Fine*. Yuh is used to teach a hole blocking

layer and does not remedy the deficiency of Kawamura. Therefore, the claims are not rendered obvious by this combination of references. Applicants request withdrawal of this 103(a) rejection.

Claims 1-3, 6-9, 14-18, 20, 24, 25, 27, 30, and 31 were rejected under 35 U.S.C. 103(a) as obvious over Kawamura in view of Mori (5,567,557). Applicants traverse the rejection.

These claims are dependent on claim 1. If claim 1 is non-obvious, then so are its dependent claims; MPEP § 2143.03, *In re Fine*. Mori is used to teach the alternative Cyanox 2176 antioxidant of instant claim 1 and does not remedy the deficiency of Kawamura. Applicants note that Mori teaches the use of a single CTL, not two CTLs as in the instant claims. Mori also teaches the use of two different antioxidants in his CTL, whereas the instant claims, due to the "consisting of" language, allow the use of only one antioxidant. Therefore, the claims are not rendered obvious by this combination of references. Applicants request withdrawal of this 103(a) rejection.


CONCLUSION

Applicants submit the pending claims (1-3, 6-18, 20-27, 30, and 31) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,
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